

# WQ 2016 Study Question (Designs)



Requirements for protection of designs – The Resolution



# Purpose of SQ

With world wide variations for

1. Definition of design
2. Name of “design”
3. Requirements to obtain available protection.

the scope of design protection and role of functionality in relation to eligibility for that protection are topics surrendered by considerable uncertainty.

Or as Christopher Carani, chair of this SQ, stated

- “It is a murky area of the law”

## Aim - Goal

The aim of this Study Question was to investigate whether the protection of design is available, what it is called and understand the requirements for such protection, with a particular focus on the role of functionality.

With design protection being one of the least harmonized area, with discord among countries and often being an unsettled area in national law the goal was to be aspirational, to take this unique opportunity to set a proposal of how we would like it to look like.

# Scope of the question – in or out of SQ

”Design”, as used within this Study Question, means a registered or patented intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture.

## **Distinguishing from**

- 1) IP right protecting technical innovation only (utility patent, utility model)
- 2) Trademarks
- 3) Copyrights

## **Outside of scope were also**

- 1) Partial designs
- 2) The relevance of the design being visible or invisible during the life of the product including such design.

# Current law and practice – summery

43 groups submitted their response

Design protection provided: – Yes, in all groups.

Name: It is very often called ”design” or ”registered design”

## Requirements for protection:

- Novelty 85% of the groups had this as a requirement
- Non-obviousness – only Taiwan and the US
- Inventive step – only China and Vietnam
- Individual character – 50% of the groups, mostly EU Countries
- Originality – 8 groups (Brazil, Bulgaria, Canada, Israel, New Zealand, Switzerland, Thailand and Vietnam)
- Aesthetic – 7 groups (Albania, Argentina, Canada, China, Israel, Japan and Singapore)
- Ornamental – 9 groups (Albania, Argentina, Brazil, Canada, Israel, Philippines, Poland, Singapore ,the US)
- Other – quite a few had other requirements as well such as industrial applicability.

# Current law and practice - functionality

Is protection to design available when the appearance is solely dictated by functionality:

**NO**, in almost all groups also in relation to a portion of the design when that portion of the overall design is solely dictated by functionality

But which the relevant factors are when determining "solely dictated by functionality" was a much more diversified question:

- a) whether the overall appearance is dictated solely by its technical function - **50%**
- b) whether each portion of the overall appearance is dictated solely by its technical function – **25%**
- c) the availability of alternative appearances that can obtain the same functional result – **33%**
- d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected – **20%**
- e) other, namely – mentions absence of aesthetic nature or lack of ornamental characters of the design or originality criterion from copyright etc

# Current law and practice – functionality and effect on scope of protection



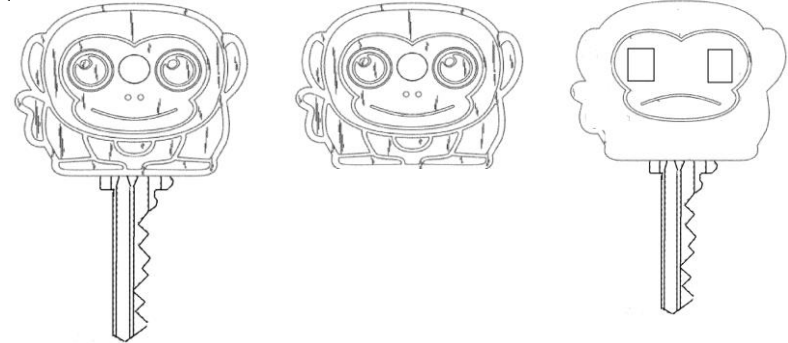
Portions deemed functional will **not be taken into account** when assessing:

- Infringement: 33% of the groups
- Validity: 25% of the groupd
- But 25% of the groups stated that even though any *portion deemed functional* will not be taken into account seperately when assessing infringement and validity it may play a role in the **overall comparison**
- It was clear that the law is unsettled in this area in many countries and this was also the main discussion point for the resolution.

# Proposal for harmonisation

Are we interested in harmonisation in the areas:

1. Definition and meaning of design
2. Requirements for protection of a design
3. Treatment of functionality



Yes, there were an interest for harmonisation in all three areas but it was clear that all groups had quite different ideas on how.

Especially the treatment of functionality when assessing validity or infringement in relation to "overall appearance" were discussed intensively.

- 1 hammer head
- 2 jaw
- 3 handle
- 4 crow bar





# The Resolution

- 1) Design protection should be available, to protect the overall visual appearance (including ornamentation) of an object or article of manufacture as a whole.
- 2) Term: "Registered Design".
- 3) At a minimum, novelty should be a requirement for protection.
- 4) No protection for the appearance of a product should be available if its appearance is dictated solely by the product's functional characteristics or functional attributes.

BUT

Protection as a registered design should be available for the appearance of a product even if a portion of the appearance is dictated solely by the product's technical Function.

# The Resolution – solely functional?

5) The assessment of whether the appearance of a product should be considered dictated solely by its technical function should include at least:

(a) whether there is no alternative appearance for the product that would obtain substantially the same technical function, and optionally

(b) whether the need to achieve the technical function of the product was the only relevant factor when the appearance of the product was arrived at.

6) A registered design should protect the appearance of a product, but should not protect separately or independently any constituent visual portions of that Appearance.

# The Resolution – scope of protection

7) Visual portions, even if solely dictated by functionality, should not be excluded when assessing the scope of protection of a registered design

But they may be given less weight in the assessment

Even if functional characteristics and functional attributes of any portion of a design shall not be protected **all** visual aspects of such portion should be considered when assessing the scope of protection.

- Size,
- Position and
- Spatial relationship

Relative the appearance of the product

# Team SQ Design

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